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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,081	02/15/2002	Michael D. Jordan	B01-74	5234
40990	7590	06/15/2005	EXAMINER	
ACUSHNET COMPANY 333 BRIDGE STREET P. O. BOX 965 FAIRHAVEN, MA 02719			GORDON, RAEANN	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/077,081

Applicant(s)

JORDAN, MICHAEL D.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7-17,35-46,48-50 and 52-73 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,64 and 68-73 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35,43-46 and 48-50 is/are allowed.
- 6) ☒ Claim(s) 1,7-17,36-42,52-63 and 65-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|---|

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7-17, 52-63, 66, and 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 – the specification does not support a Shore D hardness of 40. Also, only terpolymers have this hardness and copolymers should not be included as an option for having this hardness. Claims 7-13, 55, 56 – the base claim requires a Shore D hardness between 20 and 40 (actually 41, according to spec). Referring to page 9, lines 5-7, must also have a melt flow index between 5 and 20 and an acid content between 6% and 6.5%. Therefore, the claimed ranges are new matter. Regarding claims 52 and 53, the specification does not support a moisture vapor transmission rate less than 0.95 and less than 0.45, see page 7. Regarding claim 54, the spec does not support a terpolymer having a moisture vapor transmission rate from 0.01 to 0.9, see page 8, where this range is limited to copolymers and not terpolymers. Regarding claim 57, no support for 10 to 19% acid. Claim 58 - no support for a terpolymer having a s.g.

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between 0.93 and 0.96. No support for the upper limit of 0.96. Claims 60-61 – the specification supports either two copolymers or a copolymer and a terpolymer, two terpolymers are not supported. Claim 61 – no support for 25% to 75%, specification only supports 25%, 50%, or 75%, see page 9. Claims 66-67 – no support for a third terpolymer, see page 10.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-42 and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 limits the thickness to 0.005 and the melt flow index to 300. Claims 36-42 are broader than the base claim. Claim 59 is also broader than base claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10-13, 17, 59, 60, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (5,779,561). Regarding claim 1, Sullivan discloses a golf ball comprising a core, an inner cover layer and outer cover layer. The inner cover layer is made from a non-ionomeric copolymer and has a Shore D hardness less than

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65. Claims 10-13, the melt flow index of the material for the inner cover layer includes values of up to 5g/10min (cols 11-12). Regarding claim 17, the method of making the layer does not appear to change the final product. Claim 59, the Shore D hardness is 65 or less. Claims 60 and 62, the layer may include more than one non-ionomeric material. One of ordinary skill in the art would have varied the hardness for desired durability.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant is advised to provide page and line numbers in response to any disagreements with regards to the 112 first paragraph rejections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg
June 8, 2005



RAEANN GORDEN
PRIMARY EXAMINER